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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,692	03/27/2006	Pascale Lacan	ESSR:111US/10603706	7189
32425	7590	12/23/2009	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			ROBINSON, ELIZABETH A	
			ART UNIT	PAPER NUMBER
			1794	
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			12/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/573,692	LACAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Elizabeth Robinson	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 December 2009.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19-44 is/are pending in the application.  
 4a) Of the above claim(s) 23,24 and 44 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-22 and 25-43 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-22 and 25-43 are currently being examined.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 4, 2009 has been entered.

### ***Claim Rejections - 35 USC § 112***

**Claims 20-22, 25, 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 20-22, 25, 26 and 28 claim materials or properties for the outermost layer of the lens of claim 19. The outermost layer of the lens of claim 19 is the electrostatically adhered peelable film. While in claim 19 there is discussion of the

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outermost layer of the protective coating, when the lens is fully assembled, the peelable film is adhered to the outermost layer of the protective coating and it becomes the outermost layer of the lens. Since what is currently claimed in claims 20-22, 25, 26 and 28 is the outermost layer of the lens of claim 19, this is the peelable film. There is no support in the instant specification for such a film being made of the materials of claims 20-22, 25 and 26 or having the surface energy of claim 28.

**Claims 20-22, 25, 26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 20-22, 25, 26 and 28 state materials and properties for the outermost layer of the lens of claim 19. The outermost layer of the lens of claim 19 is the electrostatically adhered peelable film. While in claim 19 there is discussion of the outermost layer of the protective coating, when the lens is fully assembled, the peelable film is adhered to the outermost layer of the protective coating and it becomes the outermost layer of the lens. Since what is currently claimed in claims 20-22, 25, 26 and 28 is the outermost layer of the lens of claim 19, this is the peelable film. Such a film would not be made of the materials of claims 20-22, 25 and 26 or necessarily have the surface energy of claim 28. In order to further prosecution, the Examiner is interpreting that these claims limit the material for the outermost layer of the temporary protective coating.

It is noted that changing the wording of Claims 20-22, 25, 26 and 28 to say "the outermost layer of the temporary protective coating" instead of "the outermost layer" would remove the written description and indefiniteness rejections.

***Claim Rejections - 35 USC § 102***

**Claims 19, 20 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohlin (US 5,792,537).**

Regarding claims 19 and 20, Ohlin teaches an optical lens with a marking formed from a removable ink (protective coating that has an outer layer that is mechanically alterable through friction and/or contact) formed on the lens surface and then covered with a removable mask (Ohlin, claim 1). The preferred material for the mask is a static cling vinyl (Column 6, lines 33-45). The marking ink remains on the surface and then the lens is edged (Column 6, lines 4-12). Since the process of edging a lens uses a holding pad and the ink remains on the surface during the edging process, the amount of ink present must allow the lens to have some degree of adhesion to the holding pad. It is not claimed that the temporary protective layer provides the adhesion to the pad, only that the lens would adhere to a holding pad when the protective layer is present.

Regarding claims 33-36, Ohlin (Column 6, lines 33-45) teaches that the plastic material film is preferably a polyvinyl chloride film that contains 49 to 57 percent plasticizer.

**Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Lipman (US 5,451,281).**

Lipman (Column 2, line 49 through Column 3, line 12 and Figures 5-8) teaches a film that provides scratch resistance during the edging operation of a lens. The film can comprise a film with an aperture and an adhesive patch. As shown in Figure 8, the lens 7 has on its surface adhesive pad 8 and on the surface of the adhesive pad is protective film 1. The outer surface of the adhesive pad can be adhered to the mounting block and the pad, including its outermost layer, can be removed after edging is completed (Column 6, lines 15-39). Thus, the adhesive pad is a temporary protective coating that partially covers the surface of the lens and the outermost layer is mechanically alterable (can be adhered to or removed). The pad is made of butyl rubber or other polymeric material (Column 3, lines 5-7) and thus, meets the proviso of claim 19. The protective film 1 (Column 4, lines 37-68) can be a film with cling properties (electrostatically adhering). This film is releasably adhered to the lens (Column 6, lines 15-33) and thus, is peelable.

***Claim Rejections - 35 USC § 103***

**Claims 19-22, 25-32 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641) in view of Lipman (US 5,451,281).**

Regarding claims 19-22, 25 and 26, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective layer can be formed from MgF<sub>2</sub> (Page 6, lines 16-24). The temporary

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protective layer can be removed by dry wiping (Page 10, lines 25-29). For the trimming (edging) operation, the temporary protective layer is present in order to contact the self adhesive chip or double sided adhesive attached to a lens holding means (Page 8, lines 18-34). The temporary protective layer provides good adherence to the lens holding pad during the trimming (edging) operation (Page 8, line 18 through Page 9, line 9).

Conte does not teach coating the protective layer with a peelable film.

Lipman (Column 2, lines 49-66 and Figures 1-4) teaches a protective film 1 that imparts scratch resistance to a lens during the edging operation with an opening that allows attachment of the mounting block to the lens. The protective film 1 (Column 4, lines 37-68) can be a film with cling properties (electrostatically adhering). This film is releasably adhered to the lens (Column 6, lines 15-33) and thus, is peelable.

It would be obvious to one of ordinary skill in the art to use the protective film of Lipman, over the coated lens of Conte, in order to ensure that the surface of the lens is protected during the edging operation. The opening in the film of Lipman allows the coating of Conte to provide its adhesion function while still protecting the rest of the lens surface.

Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m<sup>2</sup>.

Regarding claims 29 and 30, Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous.

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claim 38, Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m<sup>2</sup>.

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

**Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipman (US 5,451,281) in view of Ohlin (US 5,792,537).**

As stated above, Lipman teaches a lens that meets the limitations of claim 19. The peelable film of Lipman can be a polyvinyl chloride film with cling properties (Column 4, lines 37-68). The film should be soft and pliable and sufficiently strong.

Lipman does not detail the specific makeup of the polyvinyl chloride film.

Ohlin (Column 6, lines 33-45) teaches a highly plasticized polyvinyl chloride cling film for protecting a lens that contains 49 to 57 percent plasticizer. With the high degree of plasticizer the film would be soft and pliable. The product has a tensile strength of 3800 psi.

It would be obvious to one of ordinary skill in the art to use the polyvinyl chloride film of Ohlin, as the film of Lipman, in order to have a specific film that has been shown to be effective for use with lenses and is soft, pliable and strong as required by Lipman.

**Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlin (US 5,792,537) in view of Mascarenhas et al. (US 5,888,615).**

Regarding claim 37, as stated above, Ohlin teaches a lens that meets the limitations of claim 19 and states that it is preferred that the plastic material film is a polyvinyl chloride cling film.

Ohlin does not explicitly state the thickness of the film.

Mascarenhas (Column 2, lines 1-15) teaches that most cling films are vinyl chloride films that comprise 50-55 weight % plasticizer and have thicknesses from about 0.004 to 0.014 inches (101 to 355 microns).

The thickness of the film of Ohlin either meets the thickness limitation of the instant claim, since this is a standard thickness for these sheets or it would be obvious to one of ordinary skill in the art to use a film with a thickness that has been shown to be effective for cling films as taught by Mascarenhas.

**Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lipman (US 5,451,281) in view of Mascarenhas et al. (US 5,888,615).**

Regarding claim 37, as stated above, Lipman teaches a lens that meets the limitations of claim 19 and that the peelable film can be a polyvinyl chloride cling film.

Lipman does not explicitly state the thickness of the film.

Mascarenhas (Column 2, lines 1-15) teaches that most cling films are vinyl chloride films that comprise 50-55 weight % plasticizer and have thicknesses from about 0.004 to 0.014 inches (101 to 355 microns).

The thickness of the film of Lipman either meets the thickness limitation of the instant claim, since this is a standard thickness for these sheets or it would be obvious to one of ordinary skill in the art to use a film with a thickness that has been shown to be effective for cling films as taught by Mascarenhas.

### ***Response to Arguments***

Applicant's arguments filed December 4, 2009 have been fully considered but they are not persuasive.

Applicant argues that the outermost layer used in all claims refers to the outermost layer of the temporary protective coating. However, the outermost layer of the lens of claim 19 is the electrostatically adhered peelable film. While in claim 19 there is discussion of the outermost layer of the protective coating, when the lens is fully assembled, the peelable film is adhered to the outermost layer of the protective coating and it becomes the outermost layer of the lens. Since what is currently claimed in

claims 20-22, 25, 26 and 28 is the outermost layer of the lens of claim 19, this is the peelable film. While the Examiner agrees that the specification and originally filed claims provide support that the outermost layer of the protective film can be formed from the claimed materials, there is not support that the outermost layer of the lens is formed from the claimed material.

Applicant argues that the ink of Ohlin does not necessarily result in sufficient adhesion to a holding pad to allow for trimming of the lens. However, it is not claimed that the temporary protective layer provides the adhesion to the pad, only that the lens would adhere to a holding pad when the protective layer is present. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a particular offset of the lens during edging) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments with respect to the rejection(s) of claim(s) 19-22, 25-36 and 38-43 under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641), in view of Ohlin (US 5,792,537) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lipman (US 5,451,281) and Conte et al. in view of Lipman.

Due to amendments to claim 19, the rejections under 35 U.S.C. 112, second paragraph over the term "amount sufficient to provide adhesion of the lens to a holding pad" are withdrawn.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is (571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. R./  
Elizabeth Robinson  
Examiner, Art Unit 1794

December 18, 2009

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794